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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,967	05/24/2001	Shawn P. Fojtik	2876-4623US	3455
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TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			LAM, ANN Y	
			ART UNIT	PAPER NUMBER
			1641	

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/864,967

Applicant(s)

FOJTIK, SHAWN P.

Examiner

Ann Y. Lam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-14, 17-21 and 24-27 is/are rejected.
- 7) ☒ Claim(s) 7,8,15,16,22 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-6 and 9-14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Anwar et al., 6,030,368.

As to claims 1, 9, 10, 11, Anwar et al. discloses a syringe barrel (80), a plunger (82); and a handle including a first member (60) configured to be held by a first part of a user's hand, said first member being pivotally connected to said syringe barrel, see Figure 1, and column 7, lines 28-31; and a second member (70) configured to be held by a second part of a user's hand, said second member being pivotally connected to said plunger, see Figure 1, and column 6, lines 51-54, said first and second members being connected one another in pivotal relation, see Figure 1, and column 5, lines 12-14.

As to claim 2, said first member is pivotally connected to said syringe barrel by way of a barrel retaining member (66, 74) for releasably retaining said syringe barrel.

As to claim 3, a plunger retaining member is disclosed at (74).

As to claim 4, first and second members are secured by a hinge (63).

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As to claims 5, 6, 12, 13 and 14, at least one of said first and second members comprise a slot (see near 63) through which said hinge extends, said slot comprises an arcuate slot.

2. Claims 1-6, 9-14, 17-21 and 24 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lane, 5,733,258.

As to claims 1, 9, 10, 11 and 21, Lane discloses a syringe barrel (26), a plunger (36); and a handle including a first member (10 and 8) configured to be held by a first part of a user's hand, said first member being pivotally connected to said syringe barrel (see Figures 1 and 7); and a second member (12) configured to be held by a second part of a user's hand, said second member being pivotally connected to said plunger, see column 9, lines 9-12, said first and second members being connected one another in pivotal relation, see column 9, lines 5-8.

As to claims 2, 17 and 18 said first member is pivotally connected to said syringe barrel by way of a barrel retaining member for releasably retaining said syringe barrel, see column 8, lines 58-61.

As to claims 3, 19 and 20, a plunger retaining member is disclosed at (22).

As to claim 4, first and second members are secured by a hinge (20).

As to claims 5, 6, 12, 13 and 14, at least one of said first and second members comprise a slot through which said hinge extends, said slot comprises an arcuate slot (near 18a.)

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As to claim 21, the injection device is used to inject fluid, see column 2, lines 57-60.

As to claim 24, the fluid comprise medicine (col. 3, line 41.)

3. Claims 1-6, 9-14 17 and 18 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by von der Decken, 5,336,201.

As to claims 1, 9, 10, 11, von der Decken discloses a syringe barrel (16), a plunger (12); and a handle including a first member (40) configured to be held by a first part of a user's hand, said first member being pivotally connected to said syringe barrel, see Figure 8; and a second member (86) capable of being held by a second part of a user's hand, said second member being pivotally connected to said plunger, see Figure 8, said first and second members being connected one another in pivotal relation, see Figure 8.

As to claims 2, 17 and 18 said first member is pivotally connected to said syringe barrel by way of a barrel retaining member (48) for releasably retaining said syringe barrel, (see column 4, lines 54-55.)

As to claim 3, a plunger retaining member is disclosed at (96, 100).

As to claim 4, first and second members are secured by a hinge (78).

As to claims 5, 6, 12, 13, 14, at least one of said first and second members comprise a slot through which said hinge extends, said slot comprises an arcuate slot (see at 78).

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 21, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pope, Jr. et al., 4,715,378, in view of Lane, 5,733,258.

Pope discloses that it is well known in the art to use a syringe to inflate an angioplasty balloon with gas, see column 1, lines 10-12, and lines 65-66, and column 4, lines 18-20. However Pope does not disclose that the syringe has two members that pivot with respect to each other as claimed by Applicant.

Lane however discloses a syringe that has pivoting members for injection the syringe having the advantage of allowing multi-doses (see above.) It would have been obvious to one of ordinary skill in the art to use a syringe such as that disclosed by Lane as the syringe used to inflate the angioplasty balloon with gas in the Pope method since the Lane device is a known type of syringe and has advantages such as allowing for multiple doses desirable for inflating a balloon.

5. Claims 21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anwar et al., 6,030,368, in view of Lane, 5,733,258.

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Anwar discloses injecting an indicator solution (col. 5, line 55) with a syringe.

However, Anwar does not disclose grasping a first handle and a second handle to pivot first handle and second handle to inject a fluid.

Lane however discloses grasping a first handle and a second handle to pivot first handle and second handle to inject a fluid (see above.) It would have been obvious to one of ordinary skill in the art to use the Lane syringe as the syringe in the Anwar method of injecting an indicator solution since the Lane device is a known type of syringe and has advantages such as allowing for multiple doses as would be desirable for injecting indicator solution.

Allowable Subject Matter

6. Claims 7, 8, 15, 16, 22 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed July 22, 2004 have been fully considered but they are not persuasive.

Applicant argues on page 7 that Anwar does not teach a first member configured to be held by a first part of a user's hand and a second member configured to be held by a second part of the user's hand. However, Examiner emphasizes that the rejected claims are directed to a device and thus a recitation of the intended use of the claimed

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invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the first and second members of Anwar are capable of being held by a user's hand as claimed and thus meet the claims.

Applicant also argues on pages 7 and 8 that with respect to claims 5, 6, 13 and 14, Anwar does not disclose a slot as claimed. Examiner reasserts that the slot is near (63) and that the slot is arcuate (since it has a curvature.)

With respect to claims 19 and 20, the previous rejections under Anwar are hereby withdrawn.

With respect to Applicant's arguments regarding the rejection of claims 21-24 and 27 under Anwar, the arguments are moot since these rejections are hereby withdrawn due to the amendments to these claims.

Applicant also argues on page 9 that Lane does not disclose that trigger (12) is pivotally connected to plunger (36). Examiner reasserts that trigger (12) is pivotally connected to plunger (36), see figure 8 for illustration of the pivoting between the parts.

Applicant also argues on page 9 that with respect to claim 3 Lane does not disclose that drag link (22) is also pivotally connected to plunger rod (36). Examiner points to figure 8 to show the pivoting between the parts.

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Applicant also argues on page 10 with respect to claims 13 and 14 that Lane does not disclose that the first member or second member includes a slot through which a hinge that connects the first and second member extends. Examiner points to hole near (18a) in figure 1 disclosing the claimed slot. The hole is considered arcuate since it has a curvature.

Applicant also argues on page 10 that with respect to claim 19 Lane does not disclose a plunger retaining element that is pivotally secured to trigger (12.) Examiner reasserts that plunger retaining member (22) is pivotally secured to trigger (12), (see figure 8 for pivoting motion.)

Applicant also argues on page 11 that Lane does not disclose grasping a first handle and a second handle to pivot the first handle and second handle toward one another. Applicant argues that trigger (12) is not pivotally associated with plunger rod (36). Examiner points to figure 8 which discloses the pivoting motion between (12) and (8 and 10).

Applicant also argues on page 11 and 12 that von der Decken does not disclose that base (36) is configured to be held by a first portion of a user's hand, while lever (76) is configured to be held by a second portion of the user's hand. However, Examiner emphasizes that the rejected claims are directed to a device and thus a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the

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intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the first and second members of von der Decken are capable of being held by a user's hand as claimed and thus meet the claims.

Applicant also argues on page 12 that with respect to claims 5, 6, 13 and 14, von der Decken does not disclose an arcuate slot as claimed. Examiner reasserts that the slot as claimed is disclosed near (78).

Applicant also argues on page 12 that with respect to claim 17 von der Decken does not disclose a barrel retaining member pivotally secured to the base (36). Examiner asserts that barrel retaining member (48) pivots with respect to base (36), see column 4, lines 53-54, and figure 5.)

With respect to claims 19 and 20, the rejection under von der Decken is hereby withdrawn.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Y. Lam whose telephone number is 571-272-0822. The examiner can normally be reached on M-Sat 11-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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11/17/09